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OFFICE OF PETITIONS

In re Application of :
Mockry, et al. :
Application No.09/878,860 :
Filed: 10 May, 2002 :
Attorney Docket No. 006385.00001 :

This is a decision on a renewed petition (styled: "Request for Reconsideration and Final Agency Action I Connection with Petition for Corrected Filing Date") filed on 12 March, 2004 (but not delivered to this office until this writing). Such a petition normally would be treated as a petition under 37 C.F.R. §1.53--which requests that the application be accorded a filing date of 9 June, 2001, rather than the presently accorded filing date of 10 May, 2002, however, by direction the decision references 37 C.F.R. §1.181.

BACKGROUND, STATUTES, REGULATIONS

The application was deposited as a nonprovisional application on 9 June, 2001, by the then-*pro se* applicants George Mockery and co-inventor Greg M. Mockery (hereinafter Messrs. George and Greg Mockery or Applicants).

On 15 March, 2002, the Office mailed a "Notice of Incomplete Nonprovisional Application" and indicated that a filing date was not granted for the application because "the specification does not include a written description of the invention."

On 10 May, 2002, Messrs. George and Greg Mockery submitted: a petition (with fee) for a filing date; a copy of the Provisional Application No. 60/211,208 filed on 13 June, 2000; a copy of

their receipt card (see: MPEP §503¹) from the deposit (the record reflects that the date stamp

¹ MPEP §503 provides in pertinent part:
§503 Application Number and Filing Receipt

* * *

If a self-addressed postcard is submitted with a patent application, that postcard will be provided with both the receipt date and application number prior to returning it to the addressee. The application number identified on such a postcard receipt is merely the preliminary assignment of an application number to the application, and should not be relied upon (e.g., with respect to foreign filings) as necessarily representing the application number assigned to such application. See 37 C.F.R. §1.53(b).

The identifying data on the postcard should include:

- (A) applicant's name(s);
- (B) title of invention;
- (C) number of pages of specification, claims (for nonprovisional applications), and sheets of drawing;
- (D) whether oath or declaration is included;
- (E) a list of any additional forms included with the application (e.g., application transmittal form, application data sheet, fee transmittal form, and/or provisional application cover sheet); and
- (F) amount and manner of paying the fee.

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 C.F.R. §1.53(a)).

OIPE mails a filing receipt to the attorney or agent, if any, otherwise to the applicant, for each application filed which meets the minimum requirements to receive a filing date. The filing receipt includes the application number, filing date, a confirmation number, a suggested class in the U.S. Patent Classification System (see MPEP §902.01), and the number of an art unit where the application is likely to be examined. The filing receipt also includes other information about the application as applicable, such as continuing data, national stage data, foreign priority data, foreign filing license data, entity status information, and the date the Office anticipates publishing the application under 35 U.S.C. §122(b). The filing receipt represents the official assignment by the USPTO of a specific application number and confirmation number to a particular application. See 37 C.F.R. §1.54(b). The application number officially assigned to an application on the filing receipt may differ from the application number identified on a postcard receipt submitted with such application, and, as between inconsistent filing receipts and postcard receipts, the application number on the filing receipt is controlling.

* * *

A nonprovisional application, other than a CPA filed under 37 C.F.R. §1.53(d), is entitled to a filing date as of the date of receipt of the specification, including claims, and any required drawing. See 37 C.F.R. §1.53(b). The filing receipt will be mailed at the time a determination is made that the application meets the minimum requirements to receive a filing date. The oath or declaration and filing fee may be filed later than the remaining application papers, but if so, they must be accompanied by the required surcharge. See 37 C.F.R. §1.53(f). If the oath or declaration, and/or filing fee, and appropriate surcharge are not timely filed, the application will be abandoned.

* * *

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the post-card initialed by the person receiving the items. Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure

6/9/019 is crossed out and a date stamp of 5/10/02 is substituted); a supporting declaration of George Mockery² contending that he assembled a copy of the provisional application, declarations for himself and his co-inventor Greg M. Mockery, a page of claims, a check in the amount of \$355.00 and a self-addressed stamped receipt card, and submitted the package via US Postal Service Express Mail on 9 June, 2001.

The petition contended that their date-stamped receipt card³ supported their plea for relief.

The 10 May petition was dismissed on 14 August, 2002.

A renewed petition filed on 7 October, 2002, argued that: the applicants, acting *pro se*, assembled and submitted the materials consisting of a copy of the provisional application; on deposit the Office did not alter the post card content listing, thus indicating that the Office received the complete application; and then on 20 December, 2001, the Office issued a filing receipt and a foreign filing license and set a projected publication date of 28 March 2002; and it was not until 15 March, 2002, that for the first time the Office determined that the application was incomplete.

The 7 October, 2002, petition was dismissed on 18 November, 2002.

In seeking further reconsideration in this matter, a petition filed by present Counsel (Petitioner)

that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO.

² The declaration of George Mockery states, in pertinent part:

* * *

During the first week of June, 2001, Greg M. Mockery and I decided to file a regular non-provisional application based on our then-pending provisional application, Ser. No. 60/211,208, filed June 13, 2000. I assembled all the papers, including Declarations signed respectively by myself and Greg M. Mockery; a specification, which was in the form of a complete copy of the above-mentioned provisional application Ser No. 60/211, 202 (sic); a page of Claims; a cashier's check from Citizen State Bank of Cortez for \$355.00; and a self-addressed stamped post card that listed each item being submitted. I then placed these materials into an envelope addressed to the Commissioner of Patents with sufficient postage for Express Mail. This envelope was deposited with the United States Postal Service on June 9, 2001.

A few days later I received back the return receipt post card, which now carried indicia showing the filing date (06/09/01) and the application serial number (09/878[.]860). The exhibit attached hereto is a true copy of the said return receipt post card. The post card has not been altered in any way since I received it.

* * *

Signed /s/ George Mockery
Dated this 15th day of April, 2002

³ The entire contents of the postcard are as follows:

NEW APPLICATION TRANSMITTAL (SMALL ENTITY)
4 ORIGINAL COPIES OF PROVISIONAL
PAGE "CLAIMS"
CASHIERS CHECK FOR \$355.00
2 DECLARATION FORMS
SELF ADDRESSED POST CARD (FOR RECEIPT PURPOSES)

on 9 September, 2003, contended that the Applicants' "postcard does itemize each of the component parts that were submitted."

The 9 September, 2003, petition was dismissed on 21 November, 2003.

Petitioner contends in the most recent petition of 12 March, 2004, that: the Office ignored Applicants' arguments of 7 October, 2003, with regard to the filing receipt mailed by the Office on 20 December, 2001; the filing receipt, rather than Applicants' receipt card, controls as to defining which items were received by the Office on the deposit date of 9 June, 2001; the Office's practice, stated at MPEP §506, imposed an "affirmative duty on the Office of Initial Patent Examination (OIPE) to give the applicant notice of any defects in the filing of a nonprovisional application, and to issue a PTO-1123 Notice of Incomplete Application."

Pertinent statutes include 35 U.S.C. §21,⁴ §111⁵ and §112⁶

⁴ 35 U.S.C. §21 states in pertinent part:

* * *

(a) The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruption or emergencies designated by the Director.

* * *

⁵ 35 U.S.C. §111 states in pertinent part:

* * *

(a) In general.

(1) Written Application. An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) Contents. Such application shall include--

(A) a specification as prescribed by section 112 of this title;
(B) a drawing as prescribed by section 113 of this title;

(C) an oath by the applicant as prescribed by section 115 of this title

(3) Fee and oath. The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) Failure to submit. Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

* * *

⁶ 35 U.S.C. §112 states in pertinent part:

* * *

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
(Emphasis supplied.)

* * *

Pertinent regulations include 37 C.F.R. §1.53(b)⁷ and §1.71.⁸

CONCLUSION

The most recent renewed petition again requests that the application be accorded a filing date of 9 June, 2001, rather than the presently accorded filing date of 10 May, 2002. Petitioner argues that the Office has failed to consider the argument that MPEP §503 is controlling in this matter.

By express direction to state that the postcard receipt constitutes sufficient evidence of receipt of the provisional application, the petition is **granted**.

The filing date of the application will be 9 June, 2001, and the fee (\$130.00) will be refunded via Treasury check to former Counsel who submitted the original payment.

The application is being forwarded to Publications Branch to be processed into a patent with a filing date of 9 June, 2001, using the copy of the application deposited on 10 May, 2002.

Telephone inquiries concerning this decision may be directed to the Office of Petitions at (703)305-9282.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁷ 37 C.F.R. §1.53(b) states in pertinent part:

Application filing requirements--Nonprovisional application. The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. §112 containing a description pursuant to §1.71 and at least one claim pursuant to §1.75, and any drawing required by §1.81(a) are filed in the Patent and Trademark Office.

⁸ 37 C.F.R. §1.71 states in pertinent part:

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
